

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:)	Group Art Unit: 2143
)	
SRINIVASAN, Thiru)	Examiner: ENGLAND, David E.
)	
Serial No.: 09/517,613)	
)	
Filed: March 2, 2000)	
)	
Atty. File No.: 1642 (42059-01010))	
)	
For: "SYSTEM AND METHOD FOR)	
AUTOMATED DOWNLOAD OF)	
MULTIMEDIA FILES")	



APPELLANTS' BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
MAIL STOP: APPEAL BRIEF - PATENTS

Dear Sir:

In response to the Notification of Non-Compliant Appeal Brief mailed July 9, 2007, the Applicant hereby submits this new Brief addressing the non-compliant portions of the originally-filed Brief. Although the Applicant believes that no other fees are due for filing this Response, please charge any fees deemed necessary to Deposit Account No. 50-1419.

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The structure of Appellant's Brief is as follows and in the order required by 37 CFR § 41.37:

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General Appendices

- A. A copy of U.S. Patent No. 6,248,946 issued to Dwek.
- B. A copy of U.S. Patent No. 6,587,127 to Leeke et al.
- C. A copy of U.S. Patent No. 6,389,467 to Eyal.
- D. A copy of U.S. Patent No. 5,987,103 to Martino.
- E. A copy of U.S. Patent No. 6,601,237 to Ten Kate.
- F. A copy of U.S. Patent No. 6,470,356 to Suzuki.
- G. A copy of U.S. Patent No. 5,953,005 to Liu.

I. REAL PARTY IN INTEREST

The inventor of the above-noted patent application has assigned all respective rights in relation to the above-noted patent application, including any resulting patent, to U.S. West, Inc., a Delaware corporation formerly with a place of business in Denver, Colorado, in the Assignment that was recorded at the U.S. Patent Office on March 2, 2000 at Reel 010665, Frame 0172. The above-noted patent application, including any resulting patent, was then assigned by U.S. West, Inc. to Qwest Communications International Inc., a Delaware corporation with a place of business in Denver, Colorado, in the Assignment that was recorded at the U.S. Patent Office on September 25, 2000 at Reel 010814, Frame 0339. Therefore, Qwest Communications International Inc. is the real party in interest in this appeal.

II. RELATED APPEALS AND INTERFERENCES

Appellant, Appellant's legal representative, the assignee of the above-noted patent application, and the named inventors for the above-noted patent application are all unaware of any appeal(s) or interference(s) which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

The status of the claims is as follows:

1. Claims pending: 1 – 7, 9 - 14 and 16 – 20;
2. Claims rejected: 1 – 7, 9 - 14 and 16 – 20;
3. Claims being appealed: 1 – 7, 9 - 14 and 16 – 20;
4. Claims cancelled: 8 and 15; and
5. Claims withdrawn: 21.

IV. STATUS OF AMENDMENTS (37 CFR § 1.192(c)(4))

The Applicant filed U.S. Patent Application No. 09/517,613 on Mar. 2, 2000. The application contained 19 total claims, 2 of which (Claims 1 and 10) were independent claims. The Applicant received a first Non Final Office Action, mailed November 21, 2002, wherein Claims 1 - 7 and 9 were rejected under 35 U.S.C. § 102(e) being as anticipated by U.S. Patent No. 6,389,467 (issued May 14, 2002; hereafter “Eyal”). Claims 8, 10, 12, and 14 – 19 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Eyal in view of U.S. Patent No. 5,987,103 (issued Nov. 16, 1999; hereafter “Martino”), and Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Eyal in view of Martino and further in view of U.S. Patent No. 6,470,356 (issued Oct. 22, 2002; hereafter “Suzuki”). Claim 11 was not explicitly rejected but was addressed in the rejections of Claims 8, 10, 12, and 14 – 19. The Applicant filed an Amendment and Response on Feb. 20, 2003, amending Claims 6, 12, 15, and 19 to address informalities and to argue the distinctions in the claims as compared to Eyal as well as combinations of Eyal with Martino and Suzuki.

The Applicant received a Final Office Action on June 2, 2003 maintaining the above rejections. The Applicant subsequently filed a response on Nov. 3, 2003 again arguing the distinctions in the claims as compared to Eyal as well as combinations of Eyal with Martino and Suzuki, particularly with respect to lack of teachings of Eyal’s provisional patent application from which the rejections are based. The Examiner, thereafter, mailed an Advisory Action to the Applicant stating that the Applicant must submit Eyal’s provisional patent application to the Examiner and proof that Eyal “does not teach or suggest the specifications that are similar to the

Applicant's invention" in spite of the Examiner's duty to do so. 37 C.F.R. § 1.104(a)(1). After the Applicant submitted Eyal's provisional patent application, the Examiner issued a second Advisory Action stating that the provisional patent application does teach portions of the Applicant's claims. Subsequently, the Applicant submitted a first Request for Continued Examination ("first RCE") with a Declaration under 37 C.F.R. § 1.131 swearing behind the Eyal reference.

In the ensuing Non Final Office Action, mailed June 18, 2004, the Examiner rejected unamended Claims 1 and 16 for the first time under 35 U.S.C. § 112, first paragraph, Claim 16 for the first time under 35 U.S.C. § 112, second paragraph, Claims 1 – 11, 13 – 15, 17 and 18 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,587,127 (issued July 1, 2003; hereafter "Leeke"), and Claims 12 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Leeke in view of Martino without once addressing the Applicant's Declaration. The Examiner also objected to the drawings under 37 C.F.R. § 1.83(a) for failing to show every feature of the invention specified in the claims. The Examiner then summarily stated that the "Applicant's arguments with respect to Claims 1- 19 have been considered but are moot in view of the new grounds of rejection". In response, the Applicant amended Claims 1, 10, and 16 and canceled Claim 15 to address the Examiner's rejections and objection, on September 20, 2004. The Applicant then received a Final Office Action, mailed Feb. 25, 2005, in which the Examiner rejected Claims 1 - 11, 13, 14, 17 and 18 under 35 U.S.C. § 102(e) as being anticipated by Leeke, Claims 12 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Leeke in view of Martino, and Claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Leeke in view of U.S. Patent No. 6,601,237 (issued July 29, 2003; hereafter "Ten Kate"), stating again that the Applicant's arguments are moot based on the new grounds for rejection this time, however, using essentially the same references. In response, the Applicant filed a second Request for Continued Examination ("second RCE"), amended Claims

1, 2, 4 - 10, added Claims 20 and 21, and argued the distinctions in the claims as compared to Leeke on June 27, 2005.

The Applicant's received a Non Final Office Action, mailed on Sept. 19, 2005, wherein the Examiner again objected to the drawings under 37 C.F.R. § 1.83(a), objected to Claim 8, rejected Claim 21 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. The Examiner also rejected Claims 1 – 9 under 35 U.S.C. § 102(c) as being anticipated by U.S. Patent No. 6,248,946 (issued June 19, 2001; hereafter "Dwek") although referenced as U.S. Patent No. 5,953,005 (issued Sept. 14, 1999). The Examiner also rejected Claims 10, 11, 13, 14, 17, 18, 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Dwek in view of Leeke. In the Non Final office action, mailed on September 19, 2005, the Examiner also issued a "Second Office Action" wherein Claims 1 - 5, 8, and 9 were rejected under 35 U.S.C. § 102(e) as being anticipated by "Liu", a reference not cited in "Notice of References Cited" form PTO-892 as required. In this Second Office Action, the Examiner also rejected Claims 6, 7, and 10, 11, 13, 14, 17, 18, 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over "Liu" in view of Leeke. In the Applicant's response thereto, filed on Dec. 19, 2005, the Applicant amended Claims 1, 2, 10, 20, and 21, argued the distinctions in the claims as compared to U.S. Patent No. 5,953,005 which is issued to a "Liu", and argued substantively that the Nov. 3, 2003 Affidavit under 37 C.F.R. § 1.131 swearing behind the Eyal reference was also effective at swearing behind the Dwek reference.

The Examiner then issued a Final Office Action, mailed on March 13, 2006, stating, for the first time and four Office Actions later, that the Applicant's Nov. 3, 2003 Affidavit under 37 C.F.R. § 1.131 was ineffective at swearing behind either Eyal or Dwek. The Examiner also objected to the drawings under 37 C.F.R. § 1.83(a) for failing to show every feature of the invention specified in the claims. The Examiner also objected to Claim 8 under 37 C.F.R. § 1.75(c) as being improper

dependent form for failing to further limit the subject matter of a previous claim. The Examiner then rejected Claim 2 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 1 - 9 were also rejected under 35 U.S.C. § 102(e) as being anticipated by Dwek, wherein the Examiner incorrectly stated the Applicant's diligence requirement for an affidavit under 37 C.F.R. § 1.131. The Examiner also rejected Claims 10, 11, 13, 14, 17, 18, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Dwek in view of Leeke and in further view of Eyal. The Examiner rejected Claims 12 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Dwek, Leeke, and Eyal as applied to Claims 10 and 11 and in further view of Martino. The Examiner also rejected Claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Dwek, Leeke, and Eyal as applied to Claims 10 and 13 and in further view of Ten Kate.

In the March 13, 2006 Final office action, the Examiner again issued an unusual "Second Office Action" in which the Examiner rejected Claims 1 - 5, 8, and 9 under 35 U.S.C. § 102(e) as being anticipated by Liu, the uncited reference. In the Second Office Action, the Examiner also rejected Claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Liu in view of Leeke. Claims 10, 11, 13, 14, 17, 18, 20, and 21 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Liu in view of Leeke and in further view of Eyal. The Examiner also rejected Claims 12 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Liu, Leeke and Eyal as applied to Claims 10 and 11 and in further view of Martino. Additionally, the Examiner rejected Claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Liu, Leeke, and Eyal as applied to Claims 10 and 13 and in further view of Ten Kate. In the Applicant's response, filed June 12, 2006, the Applicant cancelled Claim 8 and withdrew Claim 21 to render the Examiner's objections moot. The Applicant traversed all of the Examiner's remaining rejections. The Examiner mailed an Advisory Action on July 27, 2006 stating that the application was still not in condition for allowance while repeating the same incorrect logic and arguing a reference that has not been

properly cited. A Notice of Appeal was filed by Applicants on Aug. 11, 1006 and this Appeal Brief is the result thereof.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim Group A: Claims 1 - 7, 9 - 14, 16 - 19 and 20.

Generally, the present invention (Claim Group A) relates to computer software that retrieves multimedia files, such as digital music files and digital video files, from the internet. In this regard, a system for automatically retrieving and playing multimedia files includes a network access interface through which access to a data network may be attained (see e.g., page 6, lines 17 - 21, and multimedia sites 20, central site 18, internet 12) and a processing module (web browser 28 of page 7, lines 17 - 19) configured to search the data network for a first multimedia file and to return information including an identifier of the first multimedia file, a first location of the first multimedia file and a first datum relating to a first schedule of the availability of the first multimedia file (see e.g., page 2, lines 20 - 22; page 7, lines 5 - 7; and page 8, line 16 - page 9, line 12), wherein the processing module is further configured to categorize the first multimedia file and create first categorization information relating to the first multimedia file (see e.g., page 11, line 20 - page 12, line 1). The processing module is configured to search the data network for a second multimedia file and to return information including a second identifier of the second multimedia file, a second location of the second multimedia file and a second datum relating to a second schedule of the availability of the second multimedia file (see e.g., page 2, lines 20 - 22; page 7, lines 5 - 7; and page 8, line 16 - page 9, line 12). The processing module is further configured to categorize the second multimedia file and create second categorization information relating to the second multimedia file (see e.g., page 11, line 20 - page 12, line 1). The processing module, first location, and second location are situated within distinct domains within the data network (see e.g., system user 10 and multimedia sites 20 of FIG. 1; page 6, line 20 - page 7, line 11). The system also includes a selection interface (see e.g., screen displays 40, 50, 60, and 70 of FIGS. 3 - 6,

respectively) in communication with the processing module which provides for presentation of the returned information, and is configured to receive and process a selection for accessing a selected multimedia file from the data network and compile a download schedule. The system also includes a file download device (i.e., the download plug-in 34; page 8, lines 1 - 2) in communication with the selection interface which, based on the download schedule, automatically accesses the first multimedia file at the location through the network access interface and downloads the selected multimedia file.

This system may be configured as software that is operable with a computer 10. The software includes various modules that allow a user to select multimedia files, search the internet for the multimedia file selections, and download those files to the user's computer (FIG. 1 and page 6, line 16 – page 6, line 8). In this regard, the system can be summarized as providing for automatic retrieval and play multimedia files and includes a network access interface through which access to a data network may be attained (e.g., modem 22 of FIG. 2; page 7, lines 13-17). The system also includes a processing module (central processor 24 of FIG. 2; page 7, lines 12-18 and page 8, line 12) configured to search the data network (e.g., multimedia sites 20 via Internet 12 of FIG. 1) for multimedia files (see e.g., page 7, lines 5 - 7 and page 8, line 16 - page 9, line 12) and to return information including identifiers of the multimedia files, locations of the multimedia files and datum relating to schedules of availability of the multimedia files (see e.g., lines 20 - 22 of page 2 and lines 1 - 3 of page 9). The processing module is further configured to categorize the multimedia files and create categorization information relating to the multimedia files (see e.g., line 20 of page 11 - line 1 of page 12). The processing module and the locations of the multimedia files are situated within distinct domains within the data network (see e.g., system user 10 and multimedia sites 20 of FIG. 1; page 6, line 20 - page 7, line 11).

Additionally, the system includes a selection interface (see e.g., FIG. 6; page 12, lines 17-22) in communication with the processing module, which provides for presentation of the returned information. The selection interface is also configured to receive and process a selection for accessing a selected multimedia file from the data network and compile a download schedule (see e.g., FIG. 6; page 12, lines 17-22). The selection interface enables multimedia selections based on multimedia category, such as a music genre (see page 9, lines 16 - 22) and can be configured as a plug-in to a web browser (page 7, line 16 – page 8, line 2). The system also includes a file downloader (e.g., a software plugin implemented to perform the flowchart of FIG. 8 and described at page 14, line 1 - page 15, line 4) in communication with the selection interface which, based on the download schedule, automatically accesses the multimedia files at the location through the network access interface and downloads selected multimedia files.

The system further includes a scheduler that allows the user to schedule the time in which a particular multimedia file selection is to be downloaded (FIG. 6 and page 12, lines 17 – 22). For example, a selected multimedia file may be a live streaming video broadcast, such as television event or live concert, scheduled at a time which the user will not have access to a computer. The selection interface module may download the scheduling information associated with the selected multimedia file such that the file may be automatically downloaded while the user is away. In this regard, the scheduler is configured to search distinct websites for multimedia files and obtain a schedule of availability for the multimedia files. The scheduler is also a software plugin implemented to perform the flowchart of FIGs. 7a and 7b (page 12, line 10 - page 13, line 18).

Independent claim 10 is a method claim as compared to the system claim of claim 1. Similar claim language can be found to be supported in the same locations in the drawings and specification as referenced above. In this regard, the method of retrieving multimedia files over a

data network from a remote site in connection with the data network includes the step of providing a central processor (central processor 24 of FIG. 2) for searching a plurality of multimedia websites (see e.g., multimedia sites 20 of FIG. 1) for a plurality of multimedia files and a schedule of the availability of the plurality of multimedia files categorizing the plurality of multimedia files, and creating a listing containing information relating to the plurality of multimedia files. The plurality of multimedia websites searched comprises at least two websites in distinct domains of the data network. The method also includes the steps of presenting an interactive interface which includes the listing and through which individual selections may be made for downloading the multimedia files from at least one of the plurality of multimedia websites (see e.g., screen displays 40, 50, 60, and 70 of FIGs. 3 - 6, respectively), receiving an input through the interactive interface selecting a particular number of the plurality of multimedia files from the listing screen display 70 of FIG. 6), and compiling a download schedule based on the received input, wherein the schedule includes a description of the multimedia file selected, day and time for the download, and download information, including the domain (see e.g., screen display 70 of FIG. 6 configured as a software plugin to perform the processes of FIGs. 7a and 7b described on page 12, line 10 - page 13, line 18). The method further includes the step of, based on the input received through the interface, accessing and downloading over the data network, the selected multimedia files from the selected multimedia websites (e.g., download module 34 configured as a software plugin implemented to perform the flowchart of FIG. 8 and described at page 14, line 1 - page 15, line 4) .

To summarize, the “providing a central processor” step in claim 10 is supported in generally the same areas as the “processing module” limitations of claim 1. The “presenting an interactive interface,” “receiving an input,” and “compiling a download” steps of claim 10 are supported in generally the same areas as the “selection interface” limitations of claim 1. The “accessing and

downloading” step in claim 10 is supported in generally the same areas as the “file download device” limitations of claim 1.

Independent claim 20 is a system claim, as is claim 1, with some different limitations. In this regard, a system for automatically retrieving and playing multimedia files includes a network access interface through which access to a data network may be attained and a scheduler (FIG. 6 and page 12, lines 17 – 22, and e.g., screen displays 40, 50, and 60, and of FIGs. 3 - 5, respectively) configured to search a plurality of distinct websites for a multimedia file, obtain a schedule of availability of the multimedia file, categorize the multimedia file and create a first list containing information about the multimedia file (see e.g., page 6, lines 17 - 21, and multimedia sites 20, central site 18, internet 12).

The system also includes a selection interface in communication with the scheduler which provides for presentation of the first list to a user, and is configured to receive and process user inputs for accessing multimedia files from the website and compile a user download schedule (see e.g., screen displays 40, 50, 60, and 70 of FIGs. 3 - 6, respectively). The system also includes a file download device in communication with the selection interface, which, based on the user download schedule, automatically accesses the selected multimedia file through the network access interface (i.e., the download plug-in 34; page 8, lines 1 - 2).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1 – 7 and 9 have been rejected as unpatentable under 35 U.S.C. § 102(e) over Dwek (i.e., U.S. Patent No. 6,248,946).

2. Claims 10, 11, 13, 14, 17, 18, and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Dwek in view of Leeke (i.e., U.S. Patent No. 6,587,127) and in further view of Eyal (i.e., U.S. Patent No. 6,389,467).

3. Claims 12 and 19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Dwek, Leeke, and Eyal and in further view of Martino (i.e., U.S. Patent No. 5,987,103).

4. Claim 16 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Dwek, Leeke, Eyal, and in further view of Ten Kate (i.e., U.S. Patent No. 6,601,237).

5. Claims 1 – 5, and 9 have been rejected as unpatentable under 35 U.S.C. § 102(e) over “Liu”, an uncited reference.

6. Claims 6 and 7 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over “Liu” in view of Leeke.

7. Claims 10, 11, 13, 14, 17, 18, and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over “Liu” in view of Leeke and in further view of Eyal.

8. Claims 12 and 19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over “Liu”, Leeke, and Eyal and in further view of Martino.

9. Claim 16 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over “Liu”, Leeke, Eyal, and in further view of Ten Kate.

VII. ARGUMENTS

Ground 1 Rejections of Claims 1 – 7 and 9 as being unpatentable under 35 U.S.C. § 102(e) over Dwek (i.e., U.S. Patent No. 6,248,946)

The Examiner rejected Claims 1- 7, and 9 as being anticipated by Dwek. Each of the rejected claims is believed to be patentable over these references because the Applicant, on Nov. 3, 2003, submitted a 37 CFR § 1.131 Declaration (the “Declaration”) swearing behind Eyal (see e.g., Grounds of Rejection 2). Eyal has an effective filing date of Jan. 24, 2000 based on a U.S. Provisional Patent Application No. 60/177,786. The Applicant’s Declaration included, as evidence, an internal invention disclosure form dated Mar. 11, 1999 coupled with diligence, thereby effectively swearing behind Eyal. The Applicant’s declaration is also effective at swearing behind the later cited Dwek because Dwek has an effective filing date of only Mar. 1, 2000 - one day prior to the Applicant’s filing date.

Diligence is only required from a date prior to the effective date of a reference to the filing of the Applicant’s patent application. 37 C.F.R. § 1.131(b). In this case, the Declaration showed the patent attorney’s diligence in preparing a patent application from a date prior to the effective date of Eyal (Jan. 24, 2000) to the filing date of the present application (i.e., Mar. 2, 2000), a period of roughly 5 weeks. In response, the Examiner (Mr. David England) stated that the “Applicant’s arguments with respect to Claims 1 - 19 have been considered but are moot in view the new ground(s) of rejection”. Since no amendments were made to the claims when the Declaration was filed, the Examiner’s next Office Action clearly lead the Applicant to believe that the declaration was effective in removing Eyal as a reference. Later, when Dwek was cited, the Applicant’s argued that the Declaration was already effective at swearing behind Dwek. The same Examiner then, for the first time, stated that the declaration was ineffective and reinstated Eyal as prior art. This begs

the question, if the declaration was ineffective, why were there new grounds for rejection. Clearly, there should not have been because of the Examiner's duty to make a thorough examination and the Examiner should have again finally rejected the claims. 37 CFR §1.104; *see also*, MPEP § 700. In other words, the Examiner would not need additional art to reject the claims if the declaration was ineffective and he should have stated so in the following office action – not three office actions later.

Regardless, the Examiner stated that diligence had not been shown because he incorrectly interprets the requirement for diligence as being established from the date of the Applicant's invention disclosure form (i.e., Mar. 11, 1999) to the date of filing. As stated above, diligence is only required from a date before the effective date of a reference to the filing of the Applicant's patent application. 37 C.F.R. § 1.131(b) (The showing of facts shall be such...to establish...conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date...to the filing of the application).

In the declaration, the Applicant's patent attorney, Mr. Kenneth J. Johnson, swore that he prepared a patent application on December 28, 1999, a date that is prior to both Dwek and Eyal and clearly visible in the evidenced correspondence to the inventor. From that time to the date of filing, Mr. Johnson stated that he received feedback from the inventors about the patent application in January or early February 2000 (item 6 of the declaration), made corrections thereto on February 9, 2000 (item 7 of the declaration), prepared formal documents on February 21, 2000 (item 8 of the declaration), received the formal documents from the inventors on February 28, 2000 (item 9 of the declaration) and filed the application on March 2, 2000. Each of these facts clearly illustrate diligence and were supported with evidence also submitted with the Declaration. The Examiner stated that there is "almost a year from the last known correspondence to the filing of the Applicant's Application." This is simply not true. The last known correspondence from Mr.

Johnson to the inventor prior to the filing of the patent application was, in fact, only 10 days. The Applicant maintains that the declaration coupled with the associated evidence fully establishes diligence from December 28, 1999 (i.e., prior to the two referenced filing dates) through the filing of the present application on March 2, 2000 (i.e., period of just over 2 months).

The Examiner also stated that the “Applicant has not in anyway proved that the teachings in the information filed in the declaration under 37 C.F.R. § 1.131 teaches what is stated in their claim language as stated now nor is there any comparison to what was taught by the Applicant in said documents, just mere allegations”. The Applicant has shown the Examiner specific teachings in the invention disclosure form where the claims are supported. For example, the Applicant recites “software running at the centralized web site” (i.e., the claimed processing module) on page 3 of the invention disclosure form that “will organize the data received from the web sites by category”. The Applicant also discloses “a program guide” (i.e., the claimed selection interface) on page 3 of the invention disclosure form to select a broadcast program and a “player” (i.e., the claimed file download service) on pages 4 and 5 that receives a broadcast program for viewing on a computer. Scheduling of these programs as claimed is described on page 3 of the invention disclosure form.

Although these elements may have names that differ from the elements recited in the claims, there is no requirement that every word in a claim be identical to that disclosed in an information disclosure form. The only requirement must be that one skilled in the art would know how to make and use the invention without undue experimentation upon reading information disclosure form. The Applicant respectfully submits that one skilled in the art of software engineering would be enabled by the subject matter contained in the Applicant’s invention disclosure form to make and use the invention without undue experimentation upon reading the information disclosure form. Because the Applicant’s invention disclosure form exhibited in the Declaration properly supports the claims and because this invention disclosure form predates both Dwek and Eyal and diligence

during the appropriate period has been established, the Applicant believes that the Declaration effectively swears behind each of the cited references. Since the Declaration effectively swears behind the Dwek and Eyal references, Claims 1 – 7 and 9 are patentable over these references.

Ground 2 Rejections of Claims 10, 11, 13, 14, 17, 18, and 20 as being unpatentable under 35 U.S.C. § 103(a) over Dwek in view of Leeke (i.e., U.S. Patent No. 6,587,127) and in further view of Eyal (i.e., U.S. Patent No. 6,389,467)

Because the Ground 2 Rejections also rely on Dwek and Eyal, the arguments that apply to the Ground 1 Rejections of claims 1 - 7 and 9 apply herein as well. Accordingly, Claims 10, 11, 13, 14, 17, 18, and 20 are also patentable over these references.

Ground 3 Rejections of Claims 12 and 19 as being unpatentable under 35 U.S.C. § 103(a) over Dwek, Leeke, and Eyal and in further view of Martino (i.e., U.S. Patent No. 5,987,103)

Because the Ground 3 Rejections also rely on Dwek and Eyal, the arguments that apply to the Ground 1 Rejections of claims 1 - 7 and 9 apply herein as well. Accordingly, Claims 12 and 19 are also patentable over these references.

Ground 4 Rejection of Claim 16 as being unpatentable under 35 U.S.C. § 103(a) over Dwek, Leeke, Eyal, and in further view of Ten Kate (i.e., U.S. Patent No. 6,601,237)

Because the Ground 4 Rejection also relies on Dwek and Eyal, the arguments that apply to the Ground 1 Rejections of claims 1 - 7 and 9 apply herein as well. Accordingly, Claim 16 is also patentable over these references.

Ground 5 Rejections of Claims 1 – 5, and 9 as being unpatentable under 35 U.S.C. § 102(e) over “Liu”, an uncited reference

Regarding Liu (i.e., the “Second Office Action”), the Examiner did not explicitly reject Claims 1 - 5 and 9 under 35 U.S.C. § 102(e). Rather, the Examiner only provided a quote of 35 U.S.C. § 102(e) and stated afterwards that Liu teaches various elements Applicant’s claims. Additionally, the Examiner failed to properly cite Liu as a reference by including, for example, the number and date, and name of the patentee. *See e.g.*, 37 CFR § 1.104 and M.P.E.P. § 707.05. A simple search of the Patent Office patent database revealed that there are 9,407 patents having inventors with the name of Liu. Since the Applicant cannot be expected to search all of these patents to understand the applicability of “Liu” to rejected claims, the Applicant demanded a new Office Action to address the applicability of Liu. The Examiner never provided the requested information.

However, in a previous Non Final Office Action mailed on Sept. 19, 2005, the Examiner used Dwek to reject Claims 1 – 9 under 35 U.S.C. 102(e), while incorrectly referring to Dwek as U.S. Patent No. 5,953,005 (issued Sept. 14, 1999 to “Liu”). Even though U.S. Patent No. 5,953,005 has never been properly cited in a PTO form 892, the Applicant attempted to address this reference and show clear distinctions between the Applicant’s claims and the reference. When the Examiner later on relied upon “Liu” in a Final Office Action mailed Mar. 13, 2006, the Applicant could only assume that “Liu” meant U.S. Patent No. 5,953,005. Even assuming that U.S. Patent No. 5,953,005 is “Liu”, the Applicant’s claims clearly distinguish over this reference. For example, U.S. Patent No. 5,953,005 teaches an online karaoke system from which a user may select songs, but nowhere does U.S. Patent No. 5,953,005 teach any type of scheduling for the availability of a multimedia file. In fact, U.S. Patent No. 5,953,005 does not once use any form of the word schedule. Nor does U.S. Patent No. 5,953,005 teach searching a data network for a multimedia file, let alone returning

information pertaining to location of a multimedia file. U.S. Patent No. 5,953,005 simply does not teach that which the Applicant claims. Accordingly, Claims 1, 10, and 20 are patentable over U.S. Patent No. 5,953,005.

Since independent Claim 1 is patentable over U.S. Patent No. 5,953,005, the dependent claims (i.e., Claims 2 - 7, 11 - 14, and 16 - 19) are patentable as well. However, the distinctions of the Applicant's claims over U.S. Patent No. 5,953,005 do not stop at the independent claims. In Claim 5, the Applicant recites that the software of the Group A Claims may be implemented as a "plug-in" to a web browser. The Examiner states that U.S. Patent No. 5,953,005 teaches such, but U.S. Patent No. 5,953,005 only teaches "applets" at the location referenced in the Examiner's rejection. Those skilled in the art understand that a "plug-in" is a computer program that interacts with a main application, such as a web browser or an email program to provide the main application with a certain, usually very specific, function. An applet, on the other hand, is software that runs in another software program but does not provide the other software program with any additional features. Since, U.S. Patent No. 5,953,005 does not teach the Applicant's claimed plug-in, Claim 5 is patentable over this reference.

Ground 6 Rejections of Claims 6 and 7 as being unpatentable under 35 U.S.C. § 103(a) over "Liu" in view of Leeke

Because the Ground 6 Rejections also rely "Liu", the arguments that apply to the Ground 5 Rejections of claims 1 - 5 and 9 apply herein as well. Accordingly, Claims 6 and 7 are also patentable over these references.

Ground 7 Rejections of Claims 10, 11, 13, 14, 17, 18, and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over "Liu" in view of Leeke and in further view of Eyal

Because the Ground 7 Rejections also rely on “Liu”, the arguments that apply to the Ground 5 Rejections of claims 1 - 5 and 9 apply herein as well. Additionally, because the Ground 7 Rejections also rely on Eyal, the arguments that apply to the Ground 1 Rejections of claims 1 - 7 and 9 apply herein as well. Accordingly, Claims 10, 11, 13, 14, 17, 18, and 20 are also patentable over these references.

Ground 8 Rejections of Claims 12 and 19 as being unpatentable under 35 U.S.C. § 103(a) over “Liu”, Leeke, and Eyal and in further view of Martino

Because the Ground 8 Rejections also rely on “Liu”, the arguments that apply to the Ground 5 Rejections of claims 1 - 5 and 9 apply herein as well. Additionally, because the Ground 8 Rejections also rely on Eyal, the arguments that apply to the Ground 1 Rejections of claims 1 - 7 and 9 apply herein as well. Accordingly, Claims 12 and 19 are also patentable over these references.

Ground 9 Rejection of Claim 16 as being unpatentable under 35 U.S.C. § 103(a) over “Liu”, Leeke, Eyal, and in further view of Ten Kate

Because the Ground 9 Rejection also relies on “Liu”, the arguments that apply to the Ground 5 Rejections of claims 1 - 5 and 9 apply herein as well. Additionally, because the Ground 9 Rejection also relies on Eyal, the arguments that apply to the Ground 1 Rejections of claims 1 - 7 and 9 apply herein as well. Accordingly, Claim 16 is also patentable over these references.

VIII. CLAIMS APPENDIX

1. A system for automatically retrieving and playing multimedia files, comprising:
a network access interface through which access to a data network may be attained;
a processing module configured to search the data network for a first multimedia file and to return information including an identifier of said first multimedia file, a first location of said first multimedia file and a first datum relating to a first schedule of the availability of said first multimedia file, wherein said processing module is further configured to categorize said first multimedia file and create first categorization information relating to said first multimedia file;

wherein said processing module is configured to search the data network for a second multimedia file and to return information including a second identifier of said second multimedia file, a second location of said second multimedia file and a second datum relating to a second schedule of the availability of said second multimedia file, wherein said processing module is further configured to categorize said second multimedia file and create second categorization information relating to said second multimedia file;

wherein said processing module, said first location, and said second location are situated within distinct domains within the data network;

a selection interface in communication with said processing module which provides for presentation of the returned information, and is configured to receive and process a selection for accessing a selected multimedia file from the data network and compile a download schedule; and

a file download device in communication with the selection interface which, based on the download schedule, automatically accesses said first multimedia file at said location through said network access interface and downloads the selected multimedia file.

2. The system of claim 1 further including a centralized location on the data network employable to search the data network for the second multimedia file, receive information including

the second identifier of said second multimedia file, the second location of said second multimedia file, the second datum relating to the second schedule of availability of said second multimedia file and the second categorization information relating to said second multimedia file, and provide said second categorization information to the processing module.

3. The system of claim 1 wherein the data network is the Internet.
4. The system of claim 1 wherein the interface, processing module, selection interface, and download device are configured on a personal computer.
5. The system of claim 1 wherein at least one of: the processing module, the selection interface, and the file download device are configured as plugins in a web browser installed in the personal computer.
6. The system of claim 1 wherein the selection interface includes at least one of:
a first selection for real time play of said first multimedia file which is downloaded; and
a second selection for storing in a memory said first multimedia file which is downloaded in memory.
7. The system of claim 1 wherein an interface is provided for restricting categories of multimedia files to be presented by the selection interface.
9. The system of claim 6 wherein the system includes a media player for playing said first multimedia file in real time.
10. A method of retrieving multimedia files over a data network from a remote site in connection with the data network, comprising the steps of:
providing a central processor for searching a plurality of multimedia websites for a plurality of multimedia files and a schedule of the availability of said plurality of multimedia files
categorizing said plurality of multimedia files, and creating a listing containing information relating to said plurality of multimedia files;

wherein said plurality of multimedia websites searched comprise at least two websites in distinct domains of the data network;

presenting an interactive interface which includes the listing and through which individual selections may be made for downloading the multimedia files from at least one of the plurality of multimedia websites;

receiving an input through the interactive interface selecting a particular number of the plurality of multimedia files from the listing;

compiling a download schedule based on the received input, wherein the schedule includes a description of the multimedia file selected, day and time for the download, and download information, including the domain; and

based on the input received through the interface, accessing and downloading over the data network, the selected multimedia files from the selected multimedia websites.

11. The method of claim 10 further comprising at least one of the following additional steps:

storing the multimedia files in memory; and

playing the selected multimedia files.

12. The method of claim 11 wherein only a predetermined number of multimedia files may be stored in memory.

13. The method of claim 10 wherein the multimedia files are retrieved according to a time schedule.

14. The method of claim 10 wherein the data network is the Internet.

16. The method of claim 13 wherein any scheduling conflicts between the downloading of multimedia files are detected and the downloading is rescheduled as necessary to resolve conflicts.

17. The method of claim 10 wherein the listing is created based on topical categories.
18. The method of claim 17 wherein the topical categories are amended based on the received inputs.
19. The method of claim 10 wherein the listing is created and transmitted automatically on a periodic basis.
20. A system for automatically retrieving and playing multimedia files, comprising:
a network access interface through which access to a data network may be attained;
a scheduler configured to search a plurality of distinct websites for a multimedia file, obtain a schedule of availability of said multimedia file, categorize said multimedia file and create a first list containing information about said multimedia file;
a selection interface in communication with said scheduler which provides for presentation of said first list to a user, and is configured to receive and process user inputs for accessing multimedia files from said website and compile a user download schedule; and
a file download device in communication with said selection interface, which, based on said user download schedule, automatically accesses said selected multimedia file through said network access interface.

IX. EVIDENCE APPENDIX

The Applicant's Declaration submitted Nov. 3, 2003 and associated evidence establishing diligence.

X. RELATED PROCEEDINGS APPENDIX

None.

XI. CONCLUSION

Based upon the foregoing, Appellant respectfully requests the Board to reverse the Examiner's §102(e) and § 103(a) rejections of all pending claims and to pass the above-identified patent application to issuance.

Respectfully submitted,

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APPENDIX A

A copy of U.S. Patent No. 6,248,946 issued to Dwek.

APPENDIX B

A copy of U.S. Patent No. 6,587,127 to Leeke et al.

APPENDIX C

A copy of U.S. Patent No. 6,389,467 to Eyal.

APPENDIX D

A copy of U.S. Patent No. 5,987,103 to Martino.

APPENDIX E

A copy of U.S. Patent No. 6,601,237 to Ten Kate.

APPENDIX F

A copy of U.S. Patent No. 6,470,356 to Suzuki.

APPENDIX G

A copy of U.S. Patent No. 5,953,005 to Liu.